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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/336,612 06/18/99 BENDINER B 9850/3

000757 IM52/0620
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CHICAGO IL 60610

EXAMINER

CROSS, L

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/336,612

Applicant(s)

BENDINER, BERNARD

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 4, 2001 has been entered. Claims 1 and 2 are pending. Claims 3-5 have been cancelled.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,027,687 to Nakajima et al (hereinafter Nakajima et al '687).

Applicants' invention is directed to an aqueous solution comprising potassium sorbate and water, wherein the potassium sorbate is present in an amount of at least 0.3% and wherein the solution has a pH of 4.5 or higher.

Nakajima et al '687 teach a composition for effectively preventing the occurrence of corrosion in water tubes or boilers. The composition of Nakajima et al '687

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comprises, among other things, potassium sorbate, present in the amount of 0.2-2% by weight. Both examples in Table I use a pH of about 11.

It is noted that the reference does not specifically state that the resulting solution has a lower electrical conductivity and lower oxygen content, however, compositions comprising the same components present in the same amounts presumably have the like properties and characteristics. See MPEP 2112.01.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated, within the meaning of 35 USC 103 in view of the teachings of Nakajima et al '687.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,374,174 to Stricklin et al (hereinafter Stricklin et al '174).

Stricklin et al '174 disclose a composition for inhibiting the corrosion of metals comprising potassium sorbate as an active ingredient in combination with a liquid carrier which is water. The potassium sorbate is present in solution in an amount of about 10% to 70% by weight. According to the table shown at col. 3, the kraft product treated with potassium sorbate better inhibited the occurrence of corrosion than did the untreated control kraft product.

Stricklin et al '174 differ from the instantly claimed invention in that there is no specific disclosure of the pH of the solution used.

However, it would be reasonable to expect, given the superior results against corrosion of the kraft paper treated with potassium sorbate, that the pH of the solution would have to be in a range such that these results would occur. It is known in the art of metal corrosion that low pH is one of the principal causes of corrosion. One of ordinary skill in the art would then realize that a high pH would be necessary to prevent unwanted corrosion from occurring.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Stricklin et al '174.

Response to Arguments

7. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

Citation of Relevant Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 4,559,103 to Nomura et al disclose a sheet of pulp material whose corrosion resistance increased when potassium sorbate was added. See example 24.

US Patent 6,190,611 to Tachino et al disclose potassium sorbate as a reducing agent and being used for slowing the degradation of erichrome black T (EBT) when used as a hardness indicator.

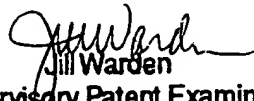
Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

LIC *SLC*
June 13, 2001


Jill Warden
Supervisory Patent Examiner
Technology Center 1700